

said elongate arms being flexible in a radially inward and radially outward direction with respect to a longitudinal axis of said prosthetic liner;

said elongate arms being formed of a predetermined material that is substantially nonstretchable in an axial direction; and

said elongate arms being embedded within said prosthetic liner.

17. (Once amended) A prosthetic liner of generally tubular shape having a rounded, closed distal end and an open proximal end for receiving a residuum, comprising:

said prosthetic liner formed of a cushioning material selected from the group consisting of silicone, urethane, and thermoformable gels;

a plurality of elongate arms extending continuously from said closed distal end in a distal-to-proximal direction;

said elongate arms being circumferentially spaced apart with respect to one another;

said elongate arms being flexible in a radially inward and radially outward direction with respect to a longitudinal axis of said prosthetic liner;

said elongate arms being formed of a predetermined material that is substantially nonstretchable in an axial direction; and

said elongate arms being secured to an exterior surface of said prosthetic liner.

REMARKS

Applicant has carefully studied the nonfinal Examiner's Action mailed August 17, 2000 and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by numbered paragraphs that correspond to the paragraphs employed by the Office, to ensure full response on the merits to each finding of the Office.

1. The disclosure stands objected to because on page 1, line 31, "if" should be --is--, on page 12, line 1, "trimable" should be --trimmable--, on page 12, line 25, "cutable" should be --cuttable--, and on page 16, line 2, "in" should be --is--. All of these corrections have been made in accordance with 37 C.F.R. § 1.121(a)(1). Moreover, the disclosure stands objected to because the "midregion 33" (page 13, line 8) is not indicated in the drawings. A proposed drawing

change is enclosed herewith and the Office's approval thereof is requested in a separate paper enclosed herewith. Reference numeral 31 in Fig. 5b has also been changed to 31a to bring the drawing into conformity with the specification at page 13, line 7.

2. Claims 1-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Reconsideration and withdrawal of this ground of rejection is requested in view of the amendments made to said claims. More particularly, the preamble of independent claim 1 has been amended to recite a prosthetic apparatus, and the prosthetic liner is clearly recited as a distinct element in claims 1-15. Line 1 of claims 2-15 has been amended so that each claim refers to the prosthetic apparatus of claim 1, once amended. Claims 16 and 17 have also been amended, but it is believed that the preamble and body of the claims of said claims are not inconsistent because no distal attachment plate is recited in said claims and the prosthetic liner and elongate arms recited in said claims are not separate elements.

3. Applicant acknowledges the quotation of 35 U.S.C. § 102(b).

4. Claims 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lohman; reconsideration and withdrawal of this ground of rejection is requested for the reasons that follow. Lohman discloses a prosthetic sock, made of a fabric. Applicant, on the other hand, discloses a prosthetic liner, made of silicone, urethane, or a similar thermoformable gel. Accordingly, this important limitation of Applicant's invention has been added to claims 16 and 17 to distinguish the invention over the contribution of Lohman. Moreover, Lohman's "movement-opposing patch surfaces 36" do not extend continuously from the distal end of the sock to a predetermined location proximal of said distal end. Instead, as indicated in all of the Lohman figures, Lohman provides a toroidal ring 38 (col. 4, line 3) at the distal end of the sock and a plurality of separate strips that do not extend to said distal end. Lohman, by placing toroidal ring 38 at the distal end of sock 32, recognized the desirability of restricting stretching at said distal end, but admitted that said toroidal ring solution was less than optimal: "Preferably, the use of circumferential patch surfaces (*i.e.* rings) around stretchable material 34 is avoided, since this may affect the stretching ability of sock 32..." (col. 4, lines 6-9). Applicant solved this problem by extending a single strip (or a plurality of strips) of nonstretchable material across the distal end of his prosthetic liner in the manner depicted in Figs. 7 and 8 (claimed in claims 16 and 17, respectively). Thus, the material is not discontinuous as in the Lohman disclosure. Accordingly, the term "continuous" has been added to claims 16 and 17 at the appropriate

location in each claim. Such addition to the claim is not new matter because the continuity of material 30 is clear from said Figs. 6 and 7. The use of such continuous strips of material was clearly not suggested by Lohman. Lohman teaches away therefrom by providing an unacceptable solution to the problem and lamenting that the solution was not optimal.


5. Applicant gratefully acknowledges the allowability of claims 1-15 if amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. Said amendments have been made and said claims are in condition for allowance.

6. Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Thus, no estoppel has been created by these amendments. See *Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 230 U.S.P.Q. 45 (Fed. Cir. 1986) ("In cases where a patentee's amendments were not required in response to an examiner's rejection, or critical to the allowance of the claims, no estoppel has been found,") citing *Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 228 U.S.P.Q. 356 (Fed. Cir. 1986) and *Datascope Corp v. SMEC, Inc.*, 776 F.2d 320, 227 U.S.P.Q. 838 (Fed. Cir. 1985). Also, see *Insta-Foam Products Inc. v. Universal Foam Systems, Inc.*, 15 U.S.P.Q. 2d 1295 (Fed. Cir. 1990).

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

By: 

Dated: September 20, 2000

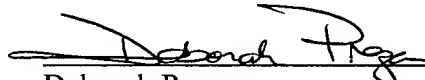
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CERTIFICATE OF MAILING
(37 C.F.R. 1.8)

I HEREBY CERTIFY that this Amendment A is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Non-Fee Amendment, Hon. Commissioner for Patents, Washington, D.C. 20231 on September 20, 2000.

Dated: September 20, 2000


Deborah Preza